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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
NGUYEN, QUANG N	
ART UNIT	**PAPER NUMBER**
2141	8

DATE MAILED: 02/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PRG

Office Action Summary	Application No. 09/668,500	Applicant(s) AMRO ET AL.	
	Examiner Quang N. Nguyen	Art Unit 2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 January 2004* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6-11,13-19,21 and 22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,6-11,13-19,21 and 22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 September 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Detail Action

1. This Office Action is in response to the Amendment B filed on 01/26/2004. Claims 1, 8, 16 and 21-22 have been amended. Claims 5, 12 and 20 are cancelled. Claims 1-4, 6-11, 13-19 and 21-22 are presented for examination.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-4, 6-11, 13-19 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jain (US 6,480,853), in view of Himmel et al. (US 6,324,566), herein after referred as Himmel.

4. As to claim 1, Jain teaches a method comprising:

storing a bookmark (user's bookmarks stored within the user's browser on a client device) (Jain, C2: L57-59);

receiving a search term and an identifier associated with the bookmark (each bookmark in the user's list of bookmarks accompanied by additional information such as keywords or phrases (i.e., identifier) can be included with a URL that is searchable by a search engine) (Jain, block 200 of Fig. 5, C6: L28-37 and C7: L16-20);

searching a database using the search term and the identifier (Jain, C7: L30-32);

searching a website associated with the bookmark using the search term and the identifier (Jain, Fig. 5 and corresponding text, C7: L23-26).

However, Jain does not explicitly teach displaying an advertisement associated with the bookmark in response to displaying the result.

In the related art, Himmel teaches a method for Internet advertising via bookmark set based on client specific information (i.e., client's search term/request), wherein an advertisement (e.g., banners/bookmarks to web pages containing articles on such client search term/request/topic) associated with the bookmark (result) set would be included, downloaded and displayed with the result set to the user (Himmel, C10: L43-61).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of Jain and Himmel for displaying an advertisement associated with the bookmark in response to displaying the result because such methods were conventionally employed in the art to allow the system to provide a new electronic advertising medium through a search engine site and provide users with additional valuable information and services related to the user's requested information/topic.

5. As to claim 2, Jain-Himmel teaches the method of claim 1, further comprising:

searching the website associated with the bookmark in response to an indicator (checkbox 14 in Fig. 4) being selected (Jain, Fig. 4 and corresponding text, C5: L48-55).

6. As to claim 3, Jain-Himmel teaches the method of claim 1, further comprising:

providing a result of searching the website associated with the bookmark to allow the result to be displayed (block 212 of Fig. 5) (Jain, C7: L27-30).

7. As to claim 4, Jain-Himmel teaches the method of claim 3, further comprising:

displaying the website in response to the result being selected (Jain, C2: L11-18).

8. As to claim 6, Jain-Himmel teaches the method of claim 1, further comprising:

providing the search term and the identifier associated with the bookmark to a search engine (web server/ search engine 26 of Fig. 2) (Jain, C7: L16-20);

searching the database using the search term in response to the search engine receiving the search term (Jain, C7: L30-32); and

searching the website associated with the bookmark using the search term in response to the search engine receiving the identifier (Jain, C7: L23-26).

9. As to claim 7, Jain-Himmel teaches the method of claim 1, further comprising:

accessing a file (i.e., a cookie) that includes the bookmark; and

creating the identifier in response to accessing the file (i.e., the search engine is configured to receive and interpret the cookie and search the bookmarks contained there within) (Jain, C6: L38-49).

10. Claims 8-11 and 13-15 are corresponding system claims of method claims 1-4 and 6-7; therefore, they are rejected under the same rationale.

11. Claims 16-19 are corresponding computer program product claims of method claims 1-3; therefore, they are rejected under the same rationale.

12. Claim 21 is a corresponding combination claim of method claims 1 and 6-7; therefore, it is rejected under the same rationale.

13. Claim 22 is a corresponding system claim of method claim 21; therefore, it is rejected under the same rationale.

Response to Arguments

14. In the remarks, applicant argued in substance that,

(**A**) Prior Arts do not show or teach "every element of the claim ..."

As to point (**A**), Examiner provides the rejection as in paragraph 4 above.

(**B**) Prior Arts fail to teach or suggest storing one or more bookmarks and using a search term along with a specific identifier for the bookmark used in a search.

As to point (**B**), **Jain** teaches user's bookmarks stored within the user's browser on a client device (C2: L57-59) and each bookmark in the user's list of bookmarks accompanied by additional information such as keywords or phrases (i.e., identifier) can be included with a URL that is searchable (i.e., used) by a search engine (C6: L28-37 and C7: L16-20).

(**C**) Examiner's conclusion of obviousness is based on improper hindsight reasoning.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does

not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).

15. Applicant's arguments as well as request for reconsideration filed on 01/26/2004 have been fully considered but they are not deemed to be persuasive.

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang N. Nguyen whose telephone number is (703) 305-8190.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's SPE, Rupal Dharia, can be reached at (703) 305-4003. The fax phone number for the organization is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Quang N. Nguyen

RUPAL DHARIA
SUPERVISORY PATENT EXAMINER